1 2 3 4	LATHAM & WATKINS Anthony I. Fenwick (Bar No. 158667) Allon Stabinsky (Bar No. 197642) 135 Commonwealth Drive Menlo Park, California 94025 Telephone: (650) 328-4600 Facsimile: (650) 463-2600				
5 6 7 8 9 10 11	BRINKS HOFER GILSON & LIONE Jack C. Berenzweig (Admitted <i>Pro Hac Vice</i> ) William H. Frankel (Admitted <i>Pro Hac Vice</i> ) Jason C. White (Admitted <i>Pro Hac Vice</i> ) Charles M. McMahon (Admitted <i>Pro Hac Vice</i> ) NBC Tower - Suite 3600 455 North Cityfront Plaza Drive Chicago, Illinois 60611 Telephone: (312) 321-4200 Facsimile: (312) 321-4299  Attorneys for Plaintiff OVERTURE SERVICES, INC.  UNITED STATES DISTRICT COURT				
13	NORTHERN DISTRICT OF CALIFORNIA				
14	SAN FRANCISCO DIVISION				
15					
16	OVERTURE SERVICES, INC., a No. C 02-01991 CRB ADR Delaware Corporation,				
17	Plaintiff,				
18	PLAINTIFF OVERTURE SERVICES'				
19	VS. REPLY TO DEFENDANT'S COUNTERCLAIMS				
20	GOOGLE INC., a California Corporation,				
21	Defendant.				
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23					
	Plaintiff Overture Services Inc. ("Overture") replies to the counterplains of				
24	Plaintiff Overture Services, Inc. ("Overture") replies to the counterclaims of				
25	Defendant Google Inc. ("Google") as follows:				
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1		General Allegations			
2	30.	Admitted.			
3	31.	Admitted.			
4	32.	Admitted.			
5	33.	Overture is informed and believes that Google is a California corporation			
6	with its principal place of business in Mountain View, California, and on that basis				
7	admits the allegations in paragraph 33.				
8	34.	Admitted.			
9		First Counterplaim			
10	First Counterclaim (Declaratory Judgment of Non-Infringement)				
11	35.	No response is necessary to the allegations incorporated from paragraphs			
12	1 through 10	. With respect to the allegations incorporated from paragraph 12, denied.			
13	With respect to the allegations incorporated from paragraphs 30 through 34, admitted.				
14	36.	Denied.			
15	37.	Denied.			
16		Second Counterclaim			
17		(Declaratory Judgment of Invalidity)			
18	38.	No response is necessary to the allegations incorporated from paragraphs			
19	1 through 10	. With respect to the allegations incorporated from paragraphs 14 and 30			
20	through 34, admitted. With respect to the allegations incorporated from paragraphs 15				
21	through 19, denied. As of April 28, 1998, GoTo.com operated a beta or test version of a				
22	system then under development, and the beta or test version of a system then under				
23	development hosted advertisements as of April 28, 1998, but the beta or test version of				
24	a system then under development was not the system claimed by the '361 patent. In				
25	addition, Ove	erture cannot respond to Google's information and belief.			
26	39.	Denied.			
27	40.	Denied.			
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# Third Counterclaim (Declaratory Judgment of Unenforceability)

- 41. No response is necessary to the allegations incorporated from paragraphs 1 through 10. With respect to the allegations incorporated from paragraphs 14 and 30 through 34, admitted. With respect to the allegations incorporated from paragraph 21, admitted, except as to the characterization of Mr. Davis as the lead named inventor. With respect to the allegations incorporated from paragraphs 15 through 19 and 22 through 29, denied. As of April 28, 1998, GoTo.com operated a beta or test version of a system then under development, and the beta or test version of a system then under development hosted advertisements as of April 28, 1998, but the beta or test version of a system then under development was not the system claimed by the '361 patent. In addition, Overture cannot respond to Google's information and belief.
  - 42. Denied.
  - 43. Denied.

## OVERTURE'S AFFIRMATIVE DEFENSES TO GOOGLE'S COUNTERCLAIMS

## First Affirmative Defense (Failure to State a Claim)

1. Google's Counterclaims for Declaratory Judgment of Non-Infringement, Invalidity, and Unenforceability fail to state a claim upon which relief may be granted.

## Second Affirmative Defense (Infringement)

2. Google is directly infringing, inducing infringement by others, and/or contributorily infringing one or more claims of the '361 patent.

## Third Affirmative Defense (Validity)

3. The claims of the '361 patent are valid and enforceable.

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# Fourth Affirmative Defense (Truth of the Statements)

- 4. The statements made by Darren J. Davis in the declaration he submitted pursuant to 27 C.FR. § 1.132 are true.
- 5. The statements made by John G. Rauch in the Amendment and Remarks submitted with Mr. Davis's declaration also are true.
- 6. Because these statements are true, there are no false statements to support Google's allegation of inequitable conduct.

# Fifth Affirmative Defense (Lack of Intent to Deceive)

- 7. Mr. Davis did not intend to deceive the U.S. Patent and Trademark Office, including in connection with the submission of his declaration.
- 8. GoTo.com did not intend to deceive the U.S. Patent and Trademark Office, including in connection with the submission of Mr. Davis's declaration.
- 9. Counsel for GoTo.com did not intend to deceive the U.S. Patent and Trademark Office, including in connection with the submission of Mr. Davis's declaration or the accompanying Amendment and Remarks.
- 10. Because there was no intent to deceive the U.S. Patent and Trademark Office, there could be no acts of inequitable conduct.

#### PRAYER

WHEREFORE, Overture prays for a judgment:

- (a) adjudging that Google has infringed the '361 patent;
- (b) adjudging that the '361 patent is enforceable and not invalid;
- (c) granting a permanent injunction restraining and enjoining Google, and its officers and representatives, from further infringement of the '361 patent during the remaining term thereof;

1	(d) awarding Overture damages for Google's infringement of the '361				
2	patent, in an amount to be determined at trial, together with prejudgment interest, and				
3	that such damages be trebled pursuant to 35 U.S.C. § 284 because of the willful and				
4	deliberate character of the infringement;				
5	(e) awarding Overture its costs and attorneys' fees, and adjudging this				
6	case to be an exceptional case pursuant to 35 U.S.C. § 285;				
7	(f) awarding such other and further relief as the Court may deem				
8	proper and just; and				
9	(g) dismissing Google's counterclaims with prejudice.				
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11	JURY DEMAND				
12	Overture hereby demands trial by jury as to all issues in this action triable by a				
13	jury.				
14					
15	Dated: June 25, 2002 By: /s/ William H. Frankel				
16	Attorney for Plaintiff OVERTURE SERVICES, INC.				
17	OVERTORE SERVICES, INC.				
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